

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and the following remarks.

By the foregoing amendments, claim 6 has been amended. No new matter has been added. Thus, claims 6, 14 and 15 are currently pending in the application and subject to examination.

Entry of this Amendment is proper under 37 C.F.R. § 1.116 since this Amendment: (a) places the application in condition for allowance for reasons discussed herein; (b) does not raise any new issue regarding further search and/or consideration since the Amendment amplifies issues previously discussed throughout prosecution; (c) does not present any additional claims without canceling a corresponding number of finally-rejected claims and (d) places the application in better form for appeal, should an appeal be necessary. The Amendment is necessary because it is made in reply to arguments raised in the rejection. Entry of the Amendment is thus respectfully requested.

In the Office Action mailed February 10, 2004, the Examiner rejected claims 6, 14 and 15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,916,532 to Streck, et al. in view of U.S. Patent No. 5,815,631 to Sugiyama, et al. It is noted that claim 6 has been amended. To the extent that the rejection remains applicable to the claims currently pending, the Applicants hereby traverse the rejection, as follows.

With regard to claim 15, the Examiner has indicated that Streck, et al. fails to explicitly teach a "message signal outputting section for outputting a message signal for

displaying a selecting state of the selector subsection on the second television receiver, to transmit the message signal through the radio-transmitter section to the slave terminal, when the selector subsection is switched to send the image signal from the second tuner section to the picture-recording device.” See, Office Action, at 3.

The Examiner further cites Sugiyama, et al. for curing the deficiency in Streck, et al., thereby rendering claim 15 obvious by incorporating “the teaching of Sugiyama into the system of Streck to provide messages from the master terminal . . . to a user at slave terminal to indicate the absence of an image signal, when recording of the same image signals being received by the slave terminal and furthermore to enable the user to be aware that the image signal is being recorded on another device.” See, Office Action, at 4.

Applicants respectfully submit, however, that neither Streck, et al. nor Sugiyama, et al., nor the combination thereof, discloses or suggests “a message signal outputting section for outputting a message signal for displaying a selecting state of said selector subsection on the second television receiver, to transmit the message signal through said radio-transmitter section to said slave terminal, when the selector subsection is switched to send the image signal from said second tuner section to the picture-recording device,” as claimed in claim 15 of the present invention.

As the Examiner notes, Sugiyama, et al. teaches a technique for controlling an audio video (“AV”) system having a plurality of audio video devices connected through cables. Specifically, Sugiyama, et al. teaches a method and apparatus for automatically terminating power to the AV devices either upon completion of the selected operation or

after a predetermined occurrence. Each of the plurality of AV devices in Sugiyama, et al. has "a controller *coupled through a control bus* to each respective controller of at least another one of the audio video devices." See Sugiyama, et al. 2:5-7, 18-20 and 34-36 (emphasis added). See also, Figures 1 and 2, and 5:14-17 ("in FIG. 2, the *controller 14 of the TV receiver 1 . . . is bidirectionally connected to the controllers 23, 33, 43, 53, 63, and 72 of the AV devices 2-7 through a control bus 9.*" (Emphasis added.) Thus, Sugiyama, et al. fails to disclose or suggest the "master terminal including . . . a radio transmitter section . . . [and] . . . at least one slave terminal including a radio-receiving station . . ." as recited in independent claim 15.

Furthermore, Sugiyama, et al. does not disclose or suggest "a message signal outputting section. . . for outputting a message signal *for displaying a selecting state* of said selector subsection on the second television receiver. . .," as claimed in claim 15 of the present invention. (Emphasis added). In fact, Sugiyama, et al. discloses "auto-all-off," "dubbing-end-all-off" and "timer-all-off" functions, all of which only terminate the power of the TV receiver 1 (the AV center) and /or to VTR 2-7, connected to the TV receiver 1 by the control bus 9. See, e.g. Sugiyama, et al. 6:6-25.

For at least these reasons, the Applicants submit that claim 15 is allowable over the cited prior art. As claim 15 is allowable, the Applicants submit that claims 6 and 14, each of which depends from allowable claim 15, are likewise allowable over the cited prior art.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of

obviousness. *In re Fine*, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *Id.* In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that "it would have been obvious to one of ordinary skill in the art to incorporate the teaching of Sugiyama into the system of Streck to provide messages from the master terminal . . . to a user at slave terminal to indicate the absence of an image signal, when recording of the same image signals being received by the slave terminal and furthermore to enable the user to be aware that the image signal is being recorded on another device." See, Office Action, at 4.

In view of the above analysis of Sugiyama, et al., the modification proposed by the Examiner is contrary to the intended purpose of the reference. Sugiyama, et al. is directed to a technique for controlling an AV system having a plurality of audio video devices connected through cables, as opposed to the wireless communication intended

in the present invention. Therefore, there is no motivation in the prior art to combine the references.

For all of the above reasons, it is respectfully submitted that the claims now pending patentably distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.


Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300, referring to client-matter number 107156-00018.

The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, referring to client-matter number 107156-00018.

Respectfully submitted,

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Enclosure: Petition for Extension of Time (one month)